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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,571	12/19/2000	Kathryn L. Parker	MS	5903
	7590	03/25/2005	#155647.1/40062.88-US-	
Homer L. Knearl Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER PATEL, HARESH N	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/741,571

Applicant(s)

PARKER ET AL.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☒ Claim(s) 3-5,7,8 and 10-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 2-18 are presented for examination. Claim 1 has been cancelled.

#### ***Response to Arguments***

2. Applicant's arguments filed 11/1/04 have been fully considered but they are not persuasive. Therefore, rejection of claims 2-18 is maintained.

Applicant argues, (1) Treyz does not disclose, “storing two or more profiles of notification events for each of one or more users in the memory of the small computer device, storing two or more profiles of notification events for each of one or more users, wherein the notification events are associated with at least one notification type, a memory unit storing a plurality of profiles for each of one or more users and the profile relating notification events with notification types”. The examiner respectfully disagrees in response to applicant's arguments. The limitations, “storing two or more profiles of notification events for each of one or more users in the memory of the small computer device, storing two or more profiles of notification events for each of one or more users, wherein the notification events are associated with at least one notification type, a memory unit storing a plurality of profiles for each of one or more users and the profile relating notification events with notification types”, has been newly added, which is addressed by the new ground(s) of rejection (please refer to the below rejections of this office action). Therefore, the rejection is maintained.

Applicant argues, (2) Treyz does not disclose, “selection of a profile based on the user's present environment, modulating notification aggressiveness based on said environment as defined by the profile, user profiles as in some claims, the profile may automatically change

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based on the user's environment, as defined by a calendar program, i.e., the calendar program may be used to drive profile (and thus, mode) selection, in place of manual control by the user".

The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies "selection of a profile based on the user's present environment, modulating notification aggressiveness based on said environment as defined by the profile, user profiles as in some claims, the profile may automatically change based on the user's environment, as defined by a calendar program, i.e., the calendar program may be used to drive profile (and thus, mode) selection, in place of manual control by the user" are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). What is claimed is "storing two or more profiles of notification events for each of one or more users in the memory of the small computer device, wherein the notification events are associated with at least one notification type, wherein each profile modules an event notification aggressiveness based on a user's present environment". Please refer to the below rejections of this office action to the newly presented amended claims. Therefore, the rejection is maintained.

### *Claim Objections*

3. Claims 3-5, 7, 8, 10-18 are objected to because of the following informalities:

Claims 3-5, 14-18 mention, "A method as defined in claim", which is incorrect. It should be "The method as defined in claim".

Claim 4 mentions, “the computer system further comprises”, which is incorrect. It should be “the method further comprises”.

Claims 7, 8 mention, “A computer program product as defined in claim”, which is incorrect. It should be “The computer program product as defined in claim”.

Claims 10-13 mention, “A computer system as defined in claim”, which is incorrect. It should be “The computer system as defined in claim”.

Claim 16 mentions, “may be notified”. The term “may be” is not allowed.

Appropriate correction is required.

#### ***Response to Amendment***

4. The amendment filed 11/01/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a) Claim 15, the addition of the limitations, “each profile modules an event notification aggressiveness based on a user’s present environment”;
- b) Claim 16, the addition of the limitations, “a user may be notified of an event in a plurality of ways, depending on a currently selected profile”; and
- c) Claim 17, the addition of the limitations, “each user must have a plurality of profiles”.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to because it does not contain subject matter containing any software or hardware to implement “each profile modules an event notification aggressiveness based on a user’s present environment”. Hence, claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The addition of the limitations, “each profile modules an event notification aggressiveness based on a user’s present environment” of claim 15, has been rejected by the examiner.
6. The specification is objected to because it does not contain subject matter containing any software or hardware to implement “a user may be notified of an event in a plurality of ways, depending on a currently selected profile”. Hence, claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The addition of the limitations, “a user may be notified of an event in a plurality of ways, depending on a currently selected profile” of claim 16, has been rejected by the examiner.
7. The specification is objected to because it does not contain subject matter containing any software or hardware to implement “each user must have a plurality of profiles”. Hence, claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The addition of the limitations, “each user must have a plurality of profiles” of claim 17, has been rejected by the examiner.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 2, 4-6, 8-11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 6, and 9 recite the limitations, “the notification events”, “the stored profiles”, “the selected notification mode”, “the selected mode”, “the user”, “the profiles. There is insufficient antecedent basis for this limitation in the claim. Since, multiple notification events, multiple stored profiles, multiple notification modes, multiple modes, multiple users and multiple profiles exist in the claim it is not clear which notification event, stored profile, notification mode, mode and user is referred by theses limitations.

Claims 4 and 8 recite the limitations, “the received selection signal”, “the selected signal”. There is insufficient antecedent basis for this limitation in the claim. Since, multiple selected signals exist in the claim it is not clear which selected signal is referred by theses limitations.

Claim 5 recites the limitations, “the notification type”. There is insufficient antecedent basis for this limitation in the claim. Since, multiple notification types exist in the claim it is not clear which notification type is referred by theses limitations.

Claims 10 and 11 recite the limitations, “the notification event”. There is insufficient antecedent basis for this limitation in the claim. Since, multiple notification events exist in the claim it is not clear which notification event is referred by theses limitations.

Claim 13 recites the limitations, “the second notification signal”. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitations, "said stored profile". There is insufficient antecedent basis for this limitation in the claim. Since, multiple stored profiles exist in the claim it is not clear which stored profile is referred by theses limitations.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 2-13, are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al. 6,587,835 (Hereinafter Treyz).

11. As per claims 2, 6 and 9, Treyz teaches the following:

a method of notifying a user of a notification event occurring in a small computer device, the small computer device having a memory (e.g., a handheld computing device, abstract), the method comprising:

a computer program product readable by a computer and encoding instructions for executing a computer process for notifying a user of notification events (e.g., a handheld computing device notifications, figure 69), the process comprising,



a computer system for notifying a user of notification events (e.g., a handheld computing device notifications, figure 69), the system comprising:

storing two or more profiles (e.g., each message type (fig. 69) denotes different profiles that a user can adjust to receive notification of events, i.e., proximity, local, notifications, etc, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65), of notification events for each of one or more users (e.g., multiple users may be supported by handheld computing device, col., 26, lines 29-33) in the memory of the small computer device wherein the notification events are associated with at least one notification type and notifying a user of an event according to the stored profile (e.g., multiple users may be supported by handheld computing device, col., 26, lines 29-33, hence, each user may access a different shopping list and set different notification settings. As disclosed in figure 69 each user after login on selects and applies a particular notification mode in order to receive a notification of an event. Each message type (fig. 69) denotes different profiles that a user can adjust to receive notification of events, i.e., proximity, local, notifications, etc, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65),

at least one profile of notification events (e.g., the user can select message types, like, proximity, local, notifications, reminders, e-mail, etc. The message types are different types of events. The alert response for each message type, like, vibration, visual only, tone, etc are the different types of notifications, which user can select for each event figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65), wherein the notification events are associated with at least one notification type (e.g., the user can select message types, like, proximity, local, notifications, reminders, e-mail, etc. The message types are different types of events. The alert response for each message type, like, vibration, visual only, tone, etc are the different types of

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notifications, which user can select for each event figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

associating each profile with a unique notification mode (e.g., the relationship between the message types (notification event) and the alert response (notification type) for each message type, like, vibration, visual only, tone, etc., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

receiving a selection signal to select one notification mode (e.g., graphical user interface prompts to the user, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

applying the selected notification mode to the small computer device wherein the device remains in the selected mode until another mode is selected and wherein the user is notified of events according to the selected notification mode, notifying a user of an event according to the stored profile (e.g., user can store his personnel settings for the messages events with the notification types and to select the events versus notification types, which can be saved locally or at a remote server and which user can modify whenever he desires to do so, figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

a memory unit for storing a plurality of profiles for each of one or more users (e.g., storage for multiple profiles and support for multiple users, figure 4, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65), the profile relating notification events with notification types (e.g., user can store his personnel settings for the messages events with the notification types and to select the events versus notification types, which can be saved locally or at a remote server and which user can modify whenever he desires to do so, figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

a first output device for notifying the user of a notification event using a first notification type (e.g., speaker to provide audible alert to the user, col. 35, lines 53-64),

a second output device for notifying the user of the notification event using a second notification type wherein the second notification type is different from the first notification type (e.g., vibration unit 116 may be used to vibrate handheld computing unit when it is desired to alert the user by vibrations without disturbing people in the vicinity of handheld computing unit by not using an audible alert, col. 15, line 64 – col.16, line 15);

a processing unit in response to a profile selected from the profiles in the memory unit automatically determining whether to notify the user using the first notification type or the second notification type ( processor, figure 4, audio tones or vibration unit, col. 15, line 64 – col.16, line 15).

12. As per claims 3-5, 7, 8, 10-13, Treyz teaches the following:

a calendar-type application program storing reminder events and wherein the selection signal is generated by the calendar-type application program, the notification event is a calendar event stored by a calendar-type application program (e.g., calendar of events at a bookstore, if the user is interested in the event, the user may select set reminder option, col. 35, lines 53-64),

the notification event is the reception of email over a wireless network, (e.g., the handheld computing device may also be used for communications functions such as sending and receiving e-mail. Wireless communications may involve short-range or local wireless links and may also involve longer-range or remote wireless links (col. 2, lines 11-15),

receiving an indication to select a notification mode (e.g., graphical user interface provided by the handheld device to the user for notification mode selections, col. 35, lines 53-64),

displaying a notification mode menu; and wherein the received selection signal relates to a selection from the displayed notification mode menu (e.g., graphical user interface providing a user to select message types, like, proximity, local, notifications, reminders, e-mail, etc. The message types are different types of events. The alert response for each message type, like, vibration, visual only, tone, etc are the different types of notifications, which user can select for each event (e.g., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

applying the selected notification mode to the small computer device and wherein the device remains in the selected mode until another mode is selected and wherein the user is notified of events according to the selected notification mode (e.g., the user can select and set notification events. The user settings are retained using the handheld device for each user. The user is also allowed to select and set notification types for the notification events. Also the user is allowed to select or modify or retain the notification type for each notification event, in the manner the user desires to do so (e.g., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

associating each profile with a unique notification mode (e.g., the user can select and set notification events. The user settings are retained using the handheld device for each user. The user is also allowed to select and set notification types for the notification events. Also the user is allowed to select or modify or retain the notification type for each notification event, in the

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manner the user desires to do so (e.g., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

receiving a selection signal to select one notification mode (e.g., graphical user interface provided by the handheld device to the user for notification mode selections, col. 35, lines 53-64),

the notification type is a vibrating signal, audible signal, visual signal or off, the first notification type is an audible signal and the second notification type is a visual display, the first notification type is a vibration signal and the second notification type is an audible signal (e.g., audio tones or vibration unit etc. with different output notification types, col. 15, line 64 – col.16, line 15).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of Wies et. al, 6,125,385 (Hereafter Wies).

15. As per claim 14, Treyz teaches the claimed limitations rejected under claim 2 as above. Treyz also teaches the concept of accessing the settings that are stored in the profile, for example, to assign/select a tone for a notification event (e.g., figure 69, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65).

However, Treyz does not specifically mention about one or more assignments of a particular sound file to a particular event.

Wies discloses one or more assignments of a particular sound file to a particular event (e.g., col., 7, lines 2-3, col., 32, line 48 – col., 33, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz with the teachings of Wies in order to facilitate assigning a particular sound file to a particular event because a sound file would be used to help provide an audio alert assigned to an event. A profile containing information related to a user including sound file selection will help the user to select different sound files for different events. The selection of a sound file for an event would help store the sound file for a user.

16. New claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of Zimmers et al., 6,816,878 (Hereinafter Zimmers).

17. As per claim 15, Treyz teaches the claimed limitations rejected under claim 2 as disclosed above. However, Treyz does not specifically mention about module an event notification aggressiveness based on a user's present environment.

Zimmers discloses the concept to module an event notification aggressiveness based on a user's present environment (e.g., col., 7, lines 5 - 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz with the teachings of Zimmers in order to facilitate module an event notification aggressiveness based on a user's present environment because the notification aggressiveness would help provide different notifications based on the event

aggressiveness. The user's present environment would help provide notification for the user. The notification with aggressiveness would help the user to know about the notification event.

18. New claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of Shetty et al., 5,808,907 (Hereinafter Shetty).

19. As per claims 16-18, Treyz teaches the claimed limitations rejected under claim 2 as disclosed above. However, Treyz does not specifically mention about a user may be notified of an event in a plurality of ways, depending on a currently selected profile, each user must have a plurality of profiles, each of a plurality of profiles contains a plurality of notifications for an event.

Shetty discloses the concept of a user notified of an event in a plurality of ways (e.g., col., 2, lines 38 - 61), depending on a currently selected profile (e.g., col., 2, lines 38 - 61), each user must have a plurality of profiles (e.g., col., 2, lines 38 - 61), each of a plurality of profiles contains a plurality of notifications for an event (e.g., col., 2, lines 38 - 61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz with the teachings of Shetty in order to facilitate a user notified of an event in a plurality of ways, depending on a currently selected profile, each user must have a plurality of profiles, each of a plurality of profiles contains a plurality of notifications for an event because the event would help notify the user. The plurality of ways would help event provided to the user. The currently selected profile would help the software know which way the event needs to be provided to the user. Having a plurality of profiles would

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help the user to support multiple events. The plurality of notifications for an event would help the event notified to the user using different notifications.

### *Conclusion*

The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

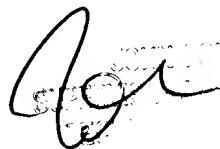
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

August 27, 2004

A handwritten signature in black ink, appearing to be 'Haresh Patel', is written over a faint, circular official stamp. The signature is fluid and cursive.